



07-17-07

FWJ

PTO/SB/21 (09-06)

Approved for use through 03/31/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/776,069
	Filing Date	Feb 11, 2004
	First Named Inventor	Sanders, Susan Q.
	Art Unit	2168
	Examiner Name	Morrison
Total Number of Pages in This Submission	Attorney Docket Number	50160

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance communication to (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks It is believed that no further request for extension of time or fees are due. Notwithstanding, the Commissioner is authorized to charge any additional fees incurred or credit any overage to Deposit Account No.50-1753 (50160). Please regard this as a further request for extension of time to the extent one is needed. (Customer Account Number 22929).		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name			
Signature			
Printed name	Sue Z. Shaper		
Date	July 16, 2007	Reg. No.	31663

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as Express mail #EV 975504797 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Signature			
Typed or printed name	Sue Z. Shaper	Date	July 16, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

In you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Sanders, et al.

Application No.: 10/776,069

Filed: 2/11/2004

Title: An Improved Internet Directory System

Attorney Docket No.: 50160

Art Unit:

2168

Examiner:

Morrison

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Mailed 5/17/07

The "Grounds of Rejection" (paragraph 9 of the Answer) repeat the Grounds of Rejection in the Action Made Final. However, paragraph 10 of the Answer (the Response to Argument section) clarifies and amplifies the Examiner's position. This Reply responds to that clarification and amplification.

Re §112 Rejections

The Answer first notifies applicant that the Amendment After Final under §1.116 was not entered. Applicant had no intent to inappropriately cause trouble with a §116 Amendment. However, frequently §112 rejections can be worked out. Applicant had responded to thirteen first Action § 112 rejections. Ten were resolved and removed. Applicant had with a good faith belief that all the §112 rejections were properly removable, based on the amendments, evidence and argument supplied. The remaining three yet appeared to be resolvable with a voluntary amendment and/or further evidence.

Specifically, the Second and Final Action retained:

1. a written description and definitiveness rejection with regard to "more than simply geographic,"
2. a lack of antecedent basis rejection for "TLD,"
3. an indefiniteness rejection in regard to "cutting edge technology."

The Response under §1.116 made a good faith attempt to resolve these three remaining §112 rejections, with additional amendment and evidence that had not previously appeared necessary.

Nonetheless, applicant traverses these remaining §112 rejections, below.

Traversal

(1) Whether “more than simply geographic” in claims 21 and 36 complies with the written description requirement and the definiteness requirement of §112.

Applicant traverses that “more than simply geographic,” is not sufficiently described in the specification and that it does not sufficiently define what is being claimed.

“More than simply geographic” distinguishes the invention from the *Yellow Pages* example of the prior art discussed in the Background section of the application. See page 2 lines 23- page 3 line 8; page 4 lines 16-28. *Yellow Pages* are organized geographically. Claim 22 recites an upper level provider’s directory of fields, super-categories and categories, and claim 36 adds that such categories and at least one field and/or super-category are “more than simply geographic.” The specification refers to the electronic yellow pages as known prior art. Yellow pages are organized geographically. Claim 36 gives notice that the therein recited category and at least one field or supercategory are “more than simply geographic. Thus, the subject matter of claims 21 and 36 reasonably conveys to one skilled in the relevant art that applicant had possession of the invention as claimed, especially since the invention as claimed was included in the specification as filed. Further, in the context of the written description, the phrase “more than simply geographic” has definition. “More than simply geographic” is not indefinite in the context of the specification.

(2) Whether the acronym “TLD” has a sufficient antecedent basis in claims 16 , 17, 24 and 25. (Please note in the statement of issues in the Appeal Brief claims 24 and 25 were inadvertently omitted from the issue relating to whether TLD had sufficient antecedent basis in the claims. Applicant requests that omission be corrected herein.)

Applicant traverses that “TLD” lacks sufficient antecedent basis. The meaning of “TLD” was pointed out, e.g. on page 12 line 22 of the specification. See also spec page 12 lines 23-27 and page 13 lines 9-10. It is well recognized in that TLD refers to “top level domain.” Those of skill in the pertinent art understand the widely used acronym TLD. Other than to explain the acronym, Applicant discerns no further basis for the rejection. The Examiner offers no clarifying explanation of the rejection. The MPEP has been consulted.

(3) Whether the phrase “cutting-edge technology,” as found in claims 18, 26 and 38, complies with the definiteness requirement of §112.

“Cutting-edge technology” is a defined and well known phrase that would be used by and recognized by one of ordinary skill in the art. The phrase is sufficiently definite to apprise one of skill in the art of the scope of the claim. In regard to “cutting edge technology” please see the Spec: page 9 line 2 and page 10 line 1; page 20 lines 5-11; and page 21 lines 2-4. “Cutting edge technology” may be a relative term but it does not render the claim “impermissibly indefinite.” New technology is discussed in

paragraph 123. Other expensive new technology is discussed in paragraph 136. Cutting edge technology is mentioned in paragraphs 55-60. Those of skill in the art understand the meaning of the term. The term falls among other relative terms that receive patentable weight.

Re §103 Rejections

The Response to Argument section of the Answer amplifies and clarifies the Examiner's position regarding the art-based rejections. Claim 1 is taken as exemplary, below. The comments apply equally to independent claim 22.

(Note: the following texts from Ans. paragraph 10 require some assumptions as to their meaning.

"It is respectfully submitted that Yahoo teaches the at least one upper-level Directory Provider, where the upper-level fields are the listings of companies, and the plurality of independently owned for-profit CDWs in its "alphabetical" list of companies." (Ans. Page 18, lines 16-19.)

"To further support this, the Examiner points to the text box and button in the middle of page 2, where the button is labeled "Search Category" which leaves doubt as to whether the PriceWatch reference teaches categories." (Ans. Page 19, lines 5-8)

Applicant also argues that PriceWatch in view of Yahoo do not teach "the CDWs being identified as Category Directory Website participating in the System by at least a mark or a URL portion," it is respectfully submitted that the PriceWatch reference, page 3, shows participation in the system is contained in every participating are in fact identified by the "Buy Online" URL." (Ans. Page 19, lines 16-20)

"In fact, the mere inclusion of in the list at any level in the System means that anything included in that business listing could be considered a "mark," given the broadest reasonable interpretation." (Ans. Page 19 line 20 – page 20 line 1.)

Applicant requests clarification to the extent that the interpretation of applicant's Examiner's clarified position, stated below, is in error.)

Applicant's Summary of Examiner's Clarified Position

- The Yahoo reference (page 1 and 2) teaches claim 1 element "(A)" (e.g. "(A)" as identified in Appeal Brief) wherein the (ref. page 1 and 2) "alphabetical list of companies" provides the claim 1 element (A) "plurality of independently owned, (from each other and from the directory provider) for-profit Category Directory Websites" and the (ref. page 1) "listing of companies" provides claim 1 element (A) "directory of upper level fields." Thus, Yahoo is asserted as teaching an upper level

directory provider (DP) providing a directory of at least upper level fields and/or super-categories and categories [identified as “the listing of companies”] and referencing a plurality of independently owned (from each other and from the directory provider) for profit category directory websites (CDWs) [identified as “the alphabetical listings of companies.”]

- PriceWatch reference (6 pages) is cited for teaching “an exemplary” CDW (category directory website) that teaches most of claim 1 element “(B),” to the extent of providing “an exemplary” CDW with at least a lower level directory referencing websites relating to a category (upper half of page 2 for categories; lower half of page 2 for items in a category and search category; and page 3 for referencing websites relating to a category.)

- Re element “(C)” PriceWatch page 3 is alleged to show “participation in the System” by the “Buy Online URL.” (Or alternately, anything in the PriceWatch reference is alleged to be considered a “mark” indicating “participating in the System.”) **Note: applicant traverses this assertion.**

- Re element “(D)” PriceWatch page 5 provides a business model to be imposed on its “participating advertisers.” [Alternately a business model of “a company” is imposed on the “alphabetical lists of companies” by Yahoo. The Examiner never expands this “company” model to the relevant dependent claims. No supporting explanation and argument is offered.]

The Acknowledged (At Least Tacitly) Differences Between Claim 1 and the Combination of Yahoo and PriceWatch

- PriceWatch is not referenced by Yahoo (the DP.) (We assume the Examiner did check the “alphabetical list of companies” and found that they did not disclose the features of a CDW. Hence reliance on a singular, non-referenced PriceWatch.)

- PriceWatch is not a “plurality.”

- PriceWatch’s participating advertiser requirements are imposed on its participating website advertisers. This is not a business model imposed on a CDW.

Examiner’s - Linking Argument to Overcome Differences

The Examiner’s position appears to be that it would have been obvious:

(1) for Yahoo’s “alphabetical list of companies” to switch to PriceWatch’s form of organization and way of doing business, including using PriceWatch’s Buy Online button as a URL portion indicative of “participation in the System;” and

(2) for Yahoo to adapt PriceWatch’s requirements for PriceWatch’s participating website advertisers and to impose it on the Yahoo “alphabetical listing of companies” as a business model.”

The motive for this selective combination is “to give more and better choices to consumers.”

TRAVERSAL

First, Applicant traverses that PriceWatch's "Buy Online" button is a URL portion that "indicates participation in the System." Applicant also traverses that a "company" is a mark imposed on the alphabetized listing of companies indicating "participation in the System." Not all elements have been identified in the references.

Second, Applicant traverses that it would be obvious to adopt PriceWatch's advertiser requirements into a business model to be imposed on category directory websites.

Third, Applicant traverses that legally sufficient motivation to make the selective combination has been supplied.

First and Second Traversal

Independent claims 1 and 22 are directed to a "System." They recite a mark or URL portion identifying a CDW as "participating in the System." They also recite imposing a System business model. The "System" is taught on page 1 lines 10-16; page 5 lines 10-22; and page 7 lines 3-10, in particular. The prior art's lack of a System-identifying URL portion (and a System business model) is discussed on page 3 lines 14-21 and page 4 line 31 to page 5 line 7. The value of a system-identifying URL portion or mark, and the value of a CDW business model, is discussed in the specification on page 5 lines 15-22 and page 5 line 28 to page 6 line 9. (Note: in applicant's preferred embodiment a URL portion is a top level domain, or TLD, such as "dir," that would be controlled by the System. See above references.) Many preferred aspects of a category directory website business model are discussed in the specification and are enumerated in the dependent claims. The combination of references does not teach the mark or URL portion limitation and does not teach the business model limitation. In particular, A "Buy Online" button is a functional button. Anyone could adopt and use it. It does not indicate "participation in a System." The Examiner does not indicate where or why he finds a "Buy Online" button to be a URL portion that indicates "participating in the System." Also, there is no legally sufficient evidence and motive presented for adopting a "participating advertiser" requirement into a CDW business model and imposing it a category directory website (absent hindsight.)

Third Traversal

Evidence presented, available of the time of filing, that the disclosed inventive selective combination would "give more and better choices to consumers," applicant submits, is legally insufficient. There is only a bare assertion. The Examiner provides neither backup evidence nor support for the bare assertion. Evidence and argument is lacking as to why a person of ordinary skill had reason to make the instant inventor's particular combination of elements, from among all available potential elements, in order to arrive at the instant inventor's system, rather than other systems. The instant inventor teaches that its particular combination of elements has a synergistic effect. The consumer is

provided with better information, faster. The category directory websites make money. The directory provider makes money. There is no evidence that the industry was moving toward the instant inventive System, or that the instant invention would occur in the ordinary course. The evidence recited in the specification, pages 1-3, is that the industry was moving in other directions.

Respectfully Submitted,

7/16/7
Date

Sue Shaper
Sue Z. Shaper
Attorney/Agent for Applicant(s)
Reg. No. 31663

Sue Z. Shaper
1800 West Loop South, Suite 1450
Houston, Texas 77027
Tel. 713 550 5710